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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/323.636 06/01/99 BARRY

J 8688.6808

EXAMINER

MMC1/1130

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ART UNIT

PAPER NUMBER

2875

DATE MAILED:

11/30/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/323,636

Applicant(s)

JAMES E. BARRY

Examiner

QUACH

Group Art Unit

2875

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three(3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 9/14/2000
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1 to 27 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☒ Claim(s) 1 to 16 is/are allowed.
- ☒ Claim(s) 17 to 27 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

***DETAILED ACTION***

***Response to Arguments***

1. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. Note that the subject matter "at least a partially transparent" body member is not supported by column 6, lines 45 to 51 as directed by the applicant on page 4 of the supplemental amendment of September 14, 2000.
2. Claims 24 and 25 do not comply with 37 CFR.1.121(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.
3. The amendment filed is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material "at least a partially transparent" body member, as claimed in claim 26, which is not supported by the original disclosure. Applicant is required to cancel the new matter in the reply to this Office action.

***Claim Rejections - 35 USC § 112***

4. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For instance, the subject matter "at least a partially transparent body member" is not supported by the original disclosure.
5. Claims 22 to 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 22, there is no clear antecedent basis for "the vehicle". Note also "a vehicle" on line 3 of claim 23.

Claims 23 to 25 depend on rejected claim 22 and as such are also rejected.

Art Unit: 2875

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 17, 20, 21 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Helm.

Helm shows a non transparent body member shaped as a gasoline tank (11), an illumination member (12, 13, ...) associated with the body member, the illumination member performing the function of a turn signal (column 3, lines 58 and 60), and means (column 3, lines 62 and 63) for energizing the illumination member.

8. Claims 22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Helm.

Helm shows the steps of providing a body member (11) in the shape of a vehicle gasoline tank, associating the illumination member (12, 13, 14, ...) with the body member so that the illumination member illuminates a surrounding area associated with a vehicle, and providing means (column 3, lines 62 to 63, and column 4, lines 4 to 4) for energizing the illumination member.

9. Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Renteria, Jr.

Renteria, Jr. shows at least a partially transparent body member (14) adapted for attachment to a gasoline tank (12), and an illumination member (42) operatively associated with the body member to provide light to illuminate an adjacent area.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2875

11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Helm.

Helm discloses the invention substantially as claimed with the exception of having the illumination member associated with a front half portion of the body member. Note that having the illumination member associated with a front half portion of the body member would have been an obvious matter of design choice which provides no unusual, unobvious, an/or unexpected result and is therefore deemed to fall within a purview of an ordinary engineering design technique to associate the illumination member with any portion of the body member depending upon where the illumination is deemed necessary to transmit a warning signal.

12. Claims 17 to 19, 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacMahon.

MacMahon discloses a non transparent body member (P-3) defined by a front half portion and a back half portion (figure 1 and figure 4), an illumination member (L-1) associated with the front half portion of the body member, at least a portion of the illumination member disposed in a removed portion (7-a) of the body member, and means (12) for energizing the illumination member. However, MacMahon does not disclose that the body member is shaped as a gasoline tank. Note that the shape of the body member would have been an obvious matter of design choice or preference which provides no unusual, unobvious, and/or unexpected result and is therefore deemed to fall within the purview of an ordinary engineering designed technique to have the body member in any desired shape for suitable and decorative purposes.

13. Claims 22 to 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacMahon.

MacMahon discloses the steps of providing a body member (P-3), an illumination member (L-1) associated with a front half portion (figures 1 and 4) of the body member closest to a front area of a vehicle so that the illumination member illuminates a surrounding area associated with the vehicle, removing a portion (7-a) of the body member, disposing at least a portion of the illumination member in the removed portion, and providing means (12) for energizing the illumination member. However, MacMahon does not disclose that the body member is shaped as

Art Unit: 2875

a gasoline tank. Note that the body member shaped as a gasoline tank would have been an obvious matter of design choice or preference which provides no unusual, unobvious, and/or unexpected result and is therefore deemed to fall within the purview of an ordinary engineering designed technique to have the body member in any desired shape for suitable and decorative purposes.

14. Claim 26 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Zahnow.

Zahnow shows at least a partially transparent body member (1, figure 1) adapted for attachment to a hollow body shell (1, figure 2), and an illumination member (4) operatively associated with the body member to provide light to illuminate an adjacent area. Note that the location where the body shell is disposed would have been an obvious matter of design choice which provides no unusual, unobvious, and/or unexpected result and is therefore deemed to fall within the purview of an ordinary engineering designed technique to dispose the body shell where it is deemed necessary to operate with the illumination member to provide a warning signal.

15. Claims 1 to 16 contain allowable subject matter.

#### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y. Quach whose telephone number is (703) 308-1939. The examiner can normally be reached on Tuesday and Thursday from 8:30 am to 4:30 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding

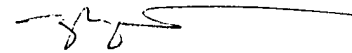
Serial Number: 09/323,636

Page 6

Art Unit: 2875

should be directed to the receptionist whose telephone number is (703) 308-0956.

Y. Q.  
November 2, 2000



Y. Quach  
Patent Examiner  
Art Unit 2875